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Henri Rosset

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EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

NOTIFICATION DATE

DELIVERY MODE

11/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/575,367	Applicant(s) ROSSET, HENRI	
	Examiner Kyle Grabowski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9-17 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9-17 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 9-10, 12, 14-16, and 19-24, are rejected under 35 U.S.C. 102(b) as being anticipated by Murakami et al. (US 5,565,276)

3. In respect to claims 1, 4, 23, and 24, Murakami et al. disclose a security paper comprising two fibrous paper plies: a first ply 20 and a second ply 10 (Col. 6, 60-65, Fig. 5); the first ply 20 ("substrate sheet") may contain a first authentication element such as dyes (i.e. colored particles) (Col. 5, 36-47); the second ply 10 may contain a second authentication element such as nacreous pigments (i.e. iridescent particles) present solely in the second ply 10 in the form of flakes (Col. 11, 17-19, Fig. 5).

4. In respect to claim 2, the second ply 10 may contain reinforcing elements for example a dry paper strength agent, polyacrylamide, a polyamide fiber (Col. 4, 43-52).

5. In respect to claims 9 and 10, the nacreous pigments also act as a reinforcing element in addition to their authentication function (providing a rigid material acts at least in some respect may constitute a reinforcing element).

6. In respect to claims 12 and 14, the first ply 20 and second ply 10 are paper plies (Col. 6, 62) and may be made of a paper-making pulp such as cotton (Col. 4, 48) and used as banknotes (Col. 12, 3-9).

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7. In respect to claims 15 and 16, although Murakami et al. does not explicitly disclose a wet-assembly process, because the claims are dependent on an apparatus claim, limitations drawn to a product-by-process are defined by the product.

8. In respect to claim 18, the first ply 20 may be 80 g/m² and the second ply 10 may be 30 g/m². Because the material is substantially the same (comprised of mostly pulp fibers) the thickness of the first ply 20 is construed to be about 2 times greater (i.e. the weight per area is inferred to substantially correlate with the thicknesses of the plies.)

9. In respect to claims 19-21, Murakami et al. disclose the claimed subject matter for the reasons stated above.

10. In respect to claim 22, Murakami et al. additionally disclose that additional plies of three or more layers may be combined (Col. 7, 6-9) and that any additional authentication elements may be used in combination such as dyed fibers or security marks (Col. 7, 10-13) which are different than watermarks. Although Murakami et al. do not specifically disclose presenting dyed fibers or security marks in the third ply it would have been obvious

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Murakami et al. (US 5,565,276). Murakami et al. does not explicitly disclose providing

polyethylene terephthalate fibers (PET) however it would have been obvious to one

having ordinary skill in the art at the time the invention was made to provide PET fibers,

as an appropriate polyamide, since it has been held to be within the general skill of a

worker in the art to select a known material on the basis of its suitability for the intended

use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. A suitable

percentages of reinforcing material are also within the purview of one of ordinary skill in

the art.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Murakami et al. (US 5,565,276) in view of Nordic Pulp and Paper Research. Murakami

substantially disclose the claimed subject matter for the reasons stated above but do

not disclose the tear strengths of any of the fibrous paper plies, however a tear index of

10 mNm²/g is dependent upon the material one selects from Murakami et al. as the

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second ply. Nordic Pulp and Paper show that a pulp such as pine kraft have a tear index above 10 mNm²/g for all brands listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select a pine kraft pulp to insure that the tear index was higher than 10 mNm²/g. Also, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US 5,565,276) in view of Williams (US 3,880,706). Murakami et al. substantially disclose the claimed subject matter for the reasons stated above, including a three ply layer, but do not disclose an intermediate layer between plies 10 and 20 having reinforcing properties however Williams discloses providing a polyamide layer between to paper plies (Abstract) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a third intermediate layer between the first and second plies in view of Williams to protect against delamination between the layers (Col. 1, 39-46).

16. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US 5,565,276) in view of Schmitz et al. (US 6,491,324). Murakami et al. substantially disclose the claimed subject matter for the reasons stated above including utilizing a security thread as an additional authentication element (Col. 7, 13)

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but do not disclose a magnetic layer, for example, that would react to microwave electronic fields however Schmitz et al. disclose a banknote utilizing a security thread having a magnetic layer (Abstract) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the security thread taught in Murakami et al. with magnetic properties to allow the security thread to be mechanically testable (Abstract, Schmitz et al.)

17. Claims 25-30, 33, 35, are rejected under 35 U.S.C. 103(a) as being unpatentable over Doublet et al. (US 6,402,888) in view of Murakami et al. (US 5,565,276).

18. In respect to claims 25, 26, and 35, Doublet et al. disclose a first ply 5 having a first authentication element, a watermark as a non-zero thickness features and a second ply 3. Either ply may be made of a synthetic or natural fibers, with any desired additives known in the art (Col. 1, 18-22, Fig. 3) to be used as a banknote. Doublet et al. does not disclose that the second ply 3 has additives such a reinforcing element however Murakami et al. disclose providing strengthening agents such as a polyamide and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the second ply 3 taught in Doublet et al. with a reinforcing element in view of Murakami et al. to strengthen the paper ply.

19. In respect to claim 27, Doublet et al. in view of Murakami et al. do not explicitly disclose providing polyethylene terephthalate fibers (PET) however it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide PET fibers, as an appropriate polyamide, since it has been held to be within the

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general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

A suitable percentages of reinforcing material are also within the purview of one of ordinary skill in the art.

20. In respect to claims 28 and 29, Doublet et al. further disclose that the second ply 3 may be imbedded with iridescent particles, a second authentication feature (Col. 5, 52-55).

21. In respect to claim 30, Doublet et al. further disclose that the first ply 5 may be significantly thicker than the second ply 3 (Fig. 3).

22. In respect to claim 33, Doublet et al. does not disclose the plies comprising cotton however Murakami et al. discloses that cotton is a suitable natural material and it would have been obvious to one of ordinary skill in the art at the time the invention was made to select cotton as a suitable material because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

23. In respect to claims 36-39, Doublet et al. further disclose that the plies are assembled wet via cylinder mold machines with watermark wire (Abstract).

24. Claims 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doublet et al. (US 6,402,888) in view of Williams (US 3,880,706).

25. Doublet et al. substantially disclose the claimed subject matter for the reasons stated above but do not disclose three plies, the middle ply comprising a reinforcing

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element however Williams discloses providing a polyamide layer between to paper plies (Abstract) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the paper taught in Doublet et al. with a third intermediate layer between the first and second plies in view of Williams to protect against delamination between the layers; the reinforcing layer may be detected under light (authentication feature) (Col. 1, 39-46).

26. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doublet et al. (US 6,402,888) as modified by Murakami et al. (US 5,565,276), as applied to claim 25, and further in view of Nordic Pulp and Paper Research. Murakami and Doublet et al. substantially disclose the claimed subject matter for the reasons stated above but do not disclose the tear strengths of any of the fibrous paper plies, however a tear index of $10 \text{ mNm}^2/\text{g}$ is dependent upon the material one selects from Murakami et al. as the second ply. Nordic Pulp and Paper show that a pulp such as pine kraft have a tear index above $10 \text{ mNm}^2/\text{g}$ for all brands listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select a pine kraft pulp to insure that the tear index was higher than $10 \text{ mNm}^2/\text{g}$. Also, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended

Response to Arguments

27. Applicant's arguments filed on 07/20/09 are moot under a new grounds of rejection. The arguments primarily pertain to the watermark authentication element which is addressed with new art on the newly filed claims. Still pertinent to the discussion, the examiner respectfully disagrees that Murakami et al. do not explicitly disclose colored particles (dyes) in each particular layer. Murakami et al. addresses each ply independently: the nacreous pigment coated paper (Col. 4, 44-55) and the substrate paper (Col. 5, 36-46). Each may independently contain a dye (colored particles).

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725